

REMARKS/ARGUMENTS

In the above-mentioned final Office Action, claims 181-264 were rejected as being anticipated by U.S. Patent 6,380,132 (Mihara *et al*) and claim 187 was rejected as being indefinite.

In response thereto, dependent claims 187, 195, 196, 213, 235 and 255 have been cancelled and new dependent claims 265-271 have been added. Additionally, claim 181 has been amended to include dependent claims 195 and 196; claim 200 has been amended to include dependent claim 213; claim 223 has been amended to include dependent claim 235, and the dependency of claim 236 has been adjusted; and claim 242 has been amended to include dependent claim 255. Claims 200 and 242 have also been amended to include "the plurality of cut lines including a plurality of horizontal cut lines and a plurality of vertical cut lines in a grid therewith." And a Declaration of Dr. Ugolick is filed herewith and hereby incorporated by reference.

The "constructed and structurally capable", "configured and constructed" and "structurally capable" and similar clauses in the claims are not "intended use" or "functional" clauses, Applicant submits. Rather, they are positive structural limitations. In this regard, the examiner's attention is directed to MPEP 2114 and MPEP 2111.04. The law is clear in that when such clauses state a condition that is material to patentability (as in the present application), they cannot be ignored (accorded no patentable weight) in order to change the substance of the invention. *See Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 74 USPQ2d 1481 (Fed. Cir. 2005). But even if the examiner does consider them to be "intended use" clauses, these recitations result in one or more distinguishing structural differences between the claimed invention and the prior art. In other words, these clauses distinguish the claimed invention over the prior art including Mihara *et al.* in terms of structure and are positive limitations to be accorded full patentable weight. This is clearly set forth in Dr. Ugolick's Declaration.

The Patent Office has spoken on this issue too: "A functional limitation must be evaluated and considered, just like any other limitation of the claim - for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient or step of

a process to define a particular capability or purpose that is served by the recited element, ingredient or step. See, for example, In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) wherein the Court held that in a claim directed to a kit of component parts capable of being assembled, limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly." 35 U.S.C. Rejections Not Based on Prior Art <http://www.uspto.gov/web/offices/pac/dapp/35usc112.htm> .

Referring to Dr. Ugolick's Declaration, Mihara *et al.* does not describe a construction which splits, divides or separates into attached first and second layer portions when folded, and specifically when folded or bent upwardly only once or downwardly only once. Cut 2 of Mihara is provided to separate the adhesive label 9 from the release sheet 5. (See Abstract; col. 3, lines 18-21; col. 3, lines 49-54; and col. 5, lines 50-55.) In fact, Mihara *et al.* does not want the release sheet 5 to break or split at the cuts 2 as this would make it more difficult to initiate removal of the labels from the release sheet by separating an easily graspable portion of the label from the release sheet. That is, users want to be able to easily grasp and peel off a unitary predefined sheet adhesive sheet portion or label without fracturing the release sheet in a Mihara *et al.* type of construction. If a portion of the release sheet were to crack and break off and remain adhered to the label, it would defeat the purpose of the Mihara cuts 2, which is to facilitate removal of the labels from the release sheet.

If the examiner contends that the Mihara *et al.* release sheet would break (split) when folded, he is requested to provide evidence, such an examiner's affidavit, which supports that contention.

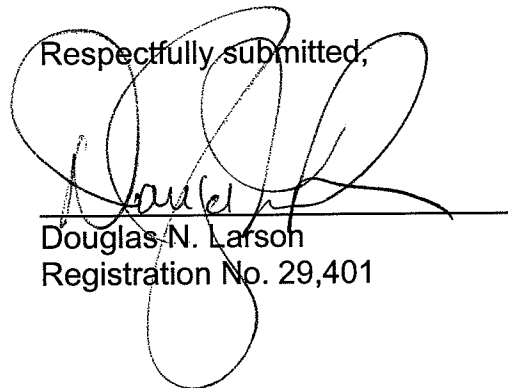
Referring to new dependent claims 265-268, an example of an internal release surface is shown in Mihara *et al.* at the interface between release sheet 5 and adhesive 6. Referring to the attached Declaration of Dr. Ugolick, the present application, as would be apparent to those skilled in the art, does not disclose an internal release surface.

Accordingly, it is respectfully contended that all of the claims now pending are in condition for allowance. Issuance of the Notice of Allowance at an early date is thus in order.

If there are any remaining issues, the examiner is encouraged to telephone the below-signed counsel for Applicant at (310) 785-5384 to seek to resolve them.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 10-0440. Should such additional fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,



Douglas N. Larson
Registration No. 29,401

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JEFFER, MANGELS, BUTLER & MARMARO LLP
1900 Avenue of the Stars, 7th Floor
Los Angeles, CA 90067-4308
Telephone: (310) 203-8080
Facsimile : (310) 712-3371